The remand being entered today was not written
for publication and is not binding precedent of the Board.

Paper No. 27

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte JAN HENDRIK MENSEN

Appeal No. 2004-1343
Application No. 09/374,598[1]

REMAND TO EXAMINER

Before HARKCOM, Acting Chief Administrative Patent Judge, WILLIAM F. SMITH and NASE, Administrative Patent Judges.

Per curiam.

REMAND TO THE EXAMINER

The above-identified application is being remanded to the examiner for appropriate action.

[1] Application filed August 13, 1999, for reissue of U.S. Patent No. 5,657,600 (Application No. 08/262,505 filed June 20, 1994).

BACKGROUND

1. A review of the file record indicates that claims 17 to 45 have been rejected under 35 U.S.C. § 251 as attempting to recapture subject matter surrendered in the application to obtain the original patent.

2. A precedential opinion concerning a reissue recapture rejection under 35 U.S.C. § 251 was decided May 29, 2003 in Ex parte Eggert, 67 USPQ2d 1716 (Bd. Pat. App. & Int. 2003). In Eggert, the majority opinion applied the fact-specific analysis set forth in In re Clement, 131 F.3d 1464, 1468-71 45 USPQ2d 1161, 1164-66 (Fed. Cir. 1997), determined that under the facts and circumstances before it, the "surrendered subject matter" was claim 1 of Eggert as that claim existed prior to the post-final rejection amendment that led to the allowance of claim 1 in the original patent, and decided that reissue claims 15-22 of Eggert were not precluded (i.e., barred) by the "recapture rule." 67 USPQ2d at 1730-33.

ACTION

We remand this application to the examiner for a determination of whether the rejection under 35 U.S.C. § 251 remains appropriate in view of Ex parte Eggert.

If the examiner determines that the rejection under 35 U.S.C. § 251 remains appropriate, the examiner is authorized to prepare a supplemental examiner's answer specifically addressing the § 251 rejection. In the event that the examiner furnishes a

supplemental answer, the appellant may file a reply brief in accordance with 37 CFR § 1.193(b)(1).

If the examiner determines that the rejection under 35 U.S.C. § 251 is no longer appropriate, the examiner should withdraw the rejection in an appropriate Office action.

CONCLUSION

This application, by virtue of its "special" status, requires immediate action, see MPEP § 708.01.

If after action by the examiner in response to this remand there still remains a decision of the examiner being appealed, the application should be promptly returned to the Board of Patent Appeals and Interferences.

GARY V. HARKCOM)
Acting Chief Administrative Patent Judge)
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WILLIAM F. SMITH) BOARD OF PATENT
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